

## **Remarks**

Please consider the following remarks in response to the Office Communication mailed on October 13, 2010.

### Statement under 37 C.F.R. §3.73(b)

A Statement under 37 C.F.R. §3.73(b) is submitted herewith. The chain of title is properly set forth in the Statement and the Statement is signed by Bernard Prandi, an authorized officer of Memometal Technologies SAS.

### Amendments Submitted Herewith

A substitute amended specification is submitted herewith in order to provide proper paragraph numbering, correct minor typographical errors and clarify the description of the invention as having to do with a monolithic interpositional arthroplasty implant for use in repairing ginglymus joints. References in the specification to a composite structure have been deleted to make it clear that the structure described and claimed is a monolith. This amendment is consistent with the drawings submitted with the application and the description of the preferred embodiments, all of which illustrate and describe a monolithic implant. No new matter is added by these amendments. The amendments to the claims submitted herewith are consistent with the amendments to the specification.

In light of the foregoing and the amendments submitted herewith, applicants respectfully submit that the specification and claims clearly indicate that the novel characteristics of the invention have to do with the fact that the implant is a monolith. The term "composite" noted by the Examiner has been deleted from the specification.

Applicants submit further that the term "consisting essentially of" in applicants' claims clearly indicates that a basic and novel characteristic of the invention is the fact that the implant is a monolith. The case law cited by the Examiner, *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354-5 (Fed. Cir. 1998), deals with the issue of ambiguity in the use of the term "consisting essentially of". Any ambiguity that may have previously existed has now been removed from the application.

### **Claim Rejections - 35 U.S.C. §102**

Claims 1-4, 19, 20, 22, and 24-25 are rejected under 35 U.S.C. §102(e) as being anticipated by Parks, et al. (U.S. Patent No. 7,025,790 B2). In making the rejection, the Examiner relies on element 50 of the multi-component prosthesis described by Parks as the basis for anticipation. In this regard, applicants respectfully direct the Examiner's attention to the decision of the Federal Circuit in *Upsher-Smith Laboratories, Inc. v. Pamlab, LLC*, 412 F.3d 1319, 1322 (Fed. Cir. 2005) wherein the Court says:

"A century old axiom of patent law holds that a product which would literally infringe if later in time anticipates if earlier...."

This axiom is the reason why one element of the Parks reference cannot be selectively removed from the other components as a basis for a rejection under 35 U.S.C. §102(e). The multi-component implant of Parks cannot be an infringement of applicants' presently claimed invention drawn to a monolithic implant. Federal Circuit decisions have repeatedly required that anticipation is established only if all of the elements as stated in a patent claim are identically set forth in a single prior art reference. Disclosure of each element is not quite enough. Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the

claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). All of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). It is not sufficient that each element be found somewhere in the reference, the elements must be arranged as in the claim. *Novo Nordisk A/S v. Becton Dickinson & Co.*, 96 F.Supp.2d 309, 312 (S.D.N.Y. 2000). Prior art anticipates an invention if a single prior art reference contains each and every element of a patent at issue operating in the same fashion to perform the identical function as the patented product. Any degree of physical difference between the patented product and the prior art, no matter how slight, defeats the claim of anticipation. *American Permahedge, Inc. v. Barcana, Inc.*, 857 F.Supp. 308, 318 (S.D.N.Y. 1994). Not only must all claimed elements be present in the prior device, but the elements must be found in substantially the same situation where they do substantially the same work. *Gillette Co. v. Warner-Lambert Co.*, 690 F.Supp. 115, 117 (D.Mass. 1988).

Element 50 of Parks is called a talar component and it is not shaped to be positioned against a tibia. Parks requires a tibial component 40 which is affixed to a prepared distal tibial surface using protrusions which match modifications made to the tibial distal surface. Parks also requires a mobile bearing 60 which is disposed between tibial component 40 and talar component 50. The talar component 50 also is not shaped to be positioned against a talus. To the contrary, the talus is modified to fit the shape, including protrusion ridges 58, of talar component 50. (See Parks, col. 9, ln. 38 to col. 10, ln. 18.) Parks is not an anticipatory reference because it does not disclose all of the elements and limitations of applicant's claims and because there are physical

differences between the claimed invention and Talar component 50 of Parks. The rejection under Section 102 must be withdrawn.

The Parks reference would also fail to support a rejection based upon obviousness because it is not obvious to make a monolithic implant where the prior art teaches that a multi-component implant is needed to do the same job. Parks accordingly teaches away from applicants' presently claimed invention.

Withdrawal of the rejection based upon Parks is respectfully requested.

Regarding the term "integral", applicants have noted the Examiner's comment and the term has been removed from the claims.

#### **Claim Rejections - 35 U.S.C. §103**


Claims 5-7, 8 and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Parks, et al. in view of Schon (U.S. Patent No. 6,572,620). Schon is combined with the primary reference, Parks, and is described as disclosing a plate (20) capable of being used as a talus-calcaneus implant having anterior and posterior lips. But Schon, like Parks, discloses a multi-component implant and, accordingly, it cannot overcome the deficiencies of Parks, which also discloses a multi-component implant. Both Parks and Schon taken alone or in combination teach away from the possibility that a monolithic implant can be used as a prosthesis for ginglymus joints in the ankle. The rejection should accordingly be withdrawn. The fact that Schon discloses the use of materials which may be used by applicants does not support the rejection because the rejected claims depend from allowable claims having to do with the structure of applicants' invention and, accordingly, the dependent claims are allowable.

#### **Conclusion**

The instant application is believed to be in condition for allowance. A Notice of Allowance of claims 1-7, 19-20, 22 and 24-25 is respectfully requested. The Examiner is invited to telephone the undersigned at (908) 722-0700 if it is believed that further discussions and/or additional amendment would help to advance the prosecution of the instant application.

If an extension of time for this response is required, applicants request that this be considered a petition therefore. Please charge any required petition fee to Deposit Account No. 14-1263.

Respectfully submitted,

By   
William R. Robinson  
Reg. No. 27,224

March 3, 2011

NORRIS MCLAUGHLIN & MARCUS, PA.  
721 Route 202-206  
P.O. BOX 5933  
Bridgewater, NJ 08807-5933  
Telephone: (908) 722-0700  
Fax: (908) 722-0755

Attorney Docket No.: 109525-002